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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,960	12/22/2000	Michael Strobel	02581-P0350A	8504

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EXAMINER

ODLAND, KATHRYN P

ART UNIT PAPER NUMBER

3743

DATE MAILED: 12/17/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/745,960

Applicant(s)

STROBEL ET AL.

Examiner

Kathryn Odland

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 15-19 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This is a response to the amendment dated November 7, 2003. Claims 1-11, 14, and 20 are under consideration. The amendments to the specification are acknowledged.

#### ***Response to Arguments***

1. Applicant's arguments filed November 7, 2003 have been fully considered but they are not persuasive.

Applicant argues that Jammet does not recite a biodegradable interference screw and that it would not be obvious to one with ordinary skill in the art to modify the invention to be bioabsorbable. However, intended use does not hold patentable weight in apparatus claims. Nonetheless, one mere example of a bioabsorbable interference screw ***for fixing ligaments*** is shown by Wolf in US Patent No. 6,629,977. Jammet et al. state in column 1, lines 60-65, "Also, the present invention proposes a screw for surgical use, particularly to serve as an anchoring for the securement of tendons and other ***ligaments***..." Thus, this teaching is for use with ligaments and can be considered applicable for use as an interference screw. Moreover, Wolf also reinforces the argument that it would be obvious to have the screw be bioabsorbable. Therefore, as previously stated in the last office action, it would be obvious to one with ordinary skill in the art to modify the invention to be bioabsorbable as well known in the art. Thus, applicant has failed to overcome the prior art rejection.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11, 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jammet et al. in US Patent No. 5,941,882.

Jammet et al. disclose a screw (120) for medical purposes having a screw body having a head portion having a facial end face, a shaft portion extending from the head portion from an end opposite to the facial end face along an axial direction of the screw body, a threading (116) provided on an outer side of the shaft portion, as recited in column 4, lines 20-40 and seen in figures 5-8; at least one axially extending groove (118) cut into an outer side of the screw body, as seen in figures 5 and 6; at least one groove extending along the head portion and an entire length of the shaft portion, as seen in figures 5 and 6; at least one groove (118) being provided for inserting a drive element of a driving tool therein, such as that shown in figure 8; a depth of the at least one axial groove is such that the drive element of the driving tool lies within the at least one axially groove and does not extend beyond an outer periphery of the screw body, as sheen in figures 6 and 8 (where size of 150 will fit that if 118 and not extend beyond); a depth of the at least one axially groove that is such that the drive element of the driving tool is housed within the groove without extending radially beyond the

threading of the shaft portion, as seen in figures 6 and 8; at least one recess (122) that is provided in the facial end face of the head portion, [where given the structure a corresponding projection on the tool **can** be introduced into the recess for centering the tool on the screw – Furthermore, functional language is not given patentable weight in an apparatus claim.]; a recess (122) that is configured as a channel completely passing through the screw body, as seen in figure 5; several axially extending grooves (118) that are provided to be distributed uniformly about a circumference of the screw body, as seen in figures 5 and 6; at least one axially extending groove is open axially at the facial end face end of the head portion, as seen in figure 5 and 6; a screw that is configured as an interference screw for anchoring a transplant in an opening in a bone, as recited in column 1, lines 59-67; and a transplant is selected from the group consisting of a tendon and a ligament, as recited in column 4, lines 59-67.

Jammet et al. disclose the invention with the exception of up to five axially extending groove that are provided to be distributed uniformly about a circumference of the screw body; a bridge that is provided for bridging the at least axially extending groove in a circumferential direction; a bridge that is provided in the head portion of the screw body; a bridge that is formed by the outer threading of the shaft portion; a screw that is made of a biodegradable material, and a shaft that tapers from the head to the opposite end face.

On the other hand, it would be obvious to one with ordinary skill in the art to modify the invention to have up to five axially extending groove that are

provided to be distributed uniformly about a circumference of the screw body.

The current application specification does not demonstrate the criticality of having up to five grooves. Therefore, it would be obvious to one with ordinary skill in the art to modify the invention to have numerous grooves where it would be system dependent based on the application.

Moreover, a bridge that is provided for bridging the at least axially extending groove in a circumferential direction; a bridge that is provided in the head portion of the screw body; and a bridge that is formed by the outer threading of the shaft portion would also be obvious to one with ordinary skill in the art and considered a matter of design choice. Again, the current specification does not provide criticality to the bridge.

Furthermore, a screw that is made of a biodegradable material and a shaft that tapers from the head to the opposite end face would also be obvious to one with ordinary skill in the art as common and extremely well known in the art.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are US Patent No. 6,629,977.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone

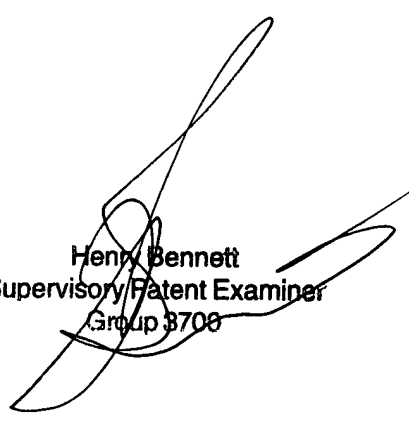
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number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

KO



Henry Bennett  
Supervisory Patent Examiner  
Group 3700